

### **REMARKS**

By this Amendment, claims 1-4, 8, 9, 13, 14, 17, 23, 26, 29 and 30 have been amended. Claims 1-30 are pending in the application. Applicant submits that the amendments do not narrow the scope of at least claims 1-4, 8, 9, 14, 17, 23 and 26. Reconsideration of the objections and rejections set forth in the Office Action is respectfully requested in view of the following remarks.

### **Allowable Subject Matter**

Applicant gratefully acknowledges the indication in the Office Action that claims 13-16, 21, 26 and 27 contain allowable subject matter. Claim 13 and 26 have been amended to recite combined features of claims 1, 11 and 13, and claims 1, 24 and 26, respectively. Accordingly, claims 13 and 26 are allowable. For the reasons stated below, however, Applicant submits that all pending claims are patentable.

### **Potential Claim Objection**

The Office Action contends that should claim 2 be found allowable, claim 3 will then be objected to under 37 C.F.R. § 1.75 as being a substantial duplicate of claim 2. Claim 3 has been amended, without narrowing its scope, to recite that "said shelf bays are arranged in groups and the shelves of one group are integral with each other." Support for this amendment is provided, for example, at paragraph [0022] of the specification. The phrase "integral with each other" means that the shelves of one group are fabricated in a one-piece construction. Applicant submits that claim 2 and claim 3, as amended, are not substantial duplicates.

**Rejection Under 35 U.S.C. § 112**

Claims 6, 7, 29 and 30 stand rejected under 35 U.S.C. §112, second paragraph.

Claim 6 recites that “said shelf bays present different widths by groups.” As explained at paragraph [0018] of the specification, the shelf bays can have different sizes only in respective groups. In other words, in such embodiment, the shelf bays in the same group can have the same size, while shelf bays in different groups can have different sizes.

Claim 7 recites that “a respective shelf bay is open to the respective laterally adjacent shelf bays.” As explained at paragraph [0019] of the specification, in an embodiment, the shelf bays do not have any limiting walls at the sides, and the bays can verge laterally into the next adjacent shelf bay in an open manner.

Claim 29 has been amended to recite that “the product supports have a first length which is greater than a total length of at least two products of a second length disposed on a respective product support one behind the other, the shelf storage facility is operable to selectively separate one of the products from the product support.” Claim 30 has been amended to recite that “the shelf storage facility is operable to selectively separate products from the product support.” Support for claims 29 and 30 is provided, for example, at paragraph [0028] of the specification, and in Figures 6-10.

Applicant submits that one having ordinary skill in the art would understand the scope and meaning of each of claims 6, 7, 29 and 30. Accordingly, these claims are in compliance with 35 U.S.C. § 112, second paragraph. See MPEP § 2173.02.

Therefore, withdrawal of the rejection is respectfully requested.

**Rejection Under 35 U.S.C. § 103**

Claims 1-5, 7-12, 17-20, 22-25 and 28 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 4,406,570 to Duncan et al. ("Duncan"), DE 19741670 to Grüner ("DE '670"), and U.S. Patent No. 5,106,259 to Anderson et al. ("Anderson"). The rejection is respectfully traversed.

The shelf storage facility recited in claim 1 can be operated to separate one of several products having different shapes and sizes disposed on a product support. For example, as was explained in the Amendment filed on May 18, 2004, with reference to Figures 6-10, the shelf storage facility can separate the single box 48C from the product support, which supports additional boxes 48a, 48b.

Duncan discloses a materials handling system for receiving articles in the form of long rolls or boxes for storing the articles in predetermined bin areas (column 6, lines 29-32). The Office Action admits that Duncan does not disclose a shelf storage facility including shelf bays and product supports associated with the shelf bays. Furthermore, for the storage of such articles in the bin areas, Duncan provides no suggestion to modify the system to include product supports, as recited in claim 1.

Duncan also does not suggest a storage and retrieval device, as recited in claim 1. Claim 1 recites that "said storage and retrieval device provides for an actuating finger adapted to be engaged in said product support and to be displaced in the longitudinal direction, as well as at least one retaining finger that is pivotable into the clearance of said receiving channel open in the upward direction" (emphasis

added). For example, Figures 6-10 of the present application illustrate the operation of an actuating finger 74 and a retaining finger 93.

The Office Action admits that Duncan does not disclose “a finger on the retrieval device.” In fact, claim 1 recites an actuating finger and at least one retaining finger. Accordingly, Duncan does not disclose or suggest such fingers, as recited in claim 1.

DE '670 discloses a system for storing vessels. The vessels are respectively positioned onto a sled 10, which is inserted in a single cell 14 and handled by a crane 6 for placing the vessel disposed on the sled into the water. See Figure 2. The Office Action contends that it would have been obvious to provide Duncan's system with a “product support” as disclosed by DE '670. Applicant respectfully disagrees.

Clearly, the DE '670 storage system is configured for storing entirely different articles than Duncan's materials handling system. Moreover, the DE '670 sled is configured to be handled by a crane, having an unrelated structure and manner of operation as compared to Duncan's alleged retrieval device. Applicant submits that DE '670 provides no suggestion to modify Duncan's system to incorporate such sled for supporting Duncan's objects.

The Office Action admits that DE '670 also does not disclose “a finger on the retrieval device.” However, it contended in the Office Action that Anderson cures this deficiency of DE '670. Applicant respectfully disagrees.

Anderson discloses a loading transport rack into which trays of products can be inserted. On each tray, products are stored. Bakery products 12 are shown in Figures 1-4 of Anderson. For replacement purposes, a pusher mechanism is

provided to move a tray into the rack at a predetermined empty position. The pusher mechanism is shown in Figure 6. Also, the pusher mechanism can unload a tray full of bread out of the rack. For making contact with a tray 11, the pusher mechanism has a projection arm 59, which can be lifted in a desired position. See Figures 7 and 8. However, the transport rack 27 does not provide a mechanism that can unload products from a tray 11.

In contrast to Anderson's apparatus, the storage and retrieval device recited in claim 1 provides an actuating finger, as well as at least one retaining finger that can be pivoted into the clearance of a receiving channel in which products are arranged. The Office Action has failed to identify such a retaining finger in the applied references. Absent such retaining finger, even if the references were combined in the manner advanced in the Office Action despite there being a lack of motivation for doing so, the references still would not suggest each and every feature recited in claim 1. Thus, the applied references fail to support any alleged case of *prima facie* obviousness with respect to claim 1. See MPEP § 2143.03, page 2100-133. Therefore, claim 1 is patentable over the applied references.

Dependent claims 2-5, 7-12, 17-20, 22-25 and 28 also are patentable for at least the same reasons as those discussed regarding claim 1.

Therefore, withdrawal of the rejection is respectfully requested.

**Conclusion**

For the foregoing reasons, issuance of a Notice of Allowance is respectfully requested. However, should the Examiner have any questions regarding this response, Applicant's undersigned representative can be reached at the telephone number given below.

Respectfully submitted,

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